

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-18 are presently active in this application, Claims 1, 5, 8, 11, 14, 16 and 17 having been amended by the present amendment.

In the outstanding Office Action Claims 1-18 were rejected under 35 USC §103(a) as being unpatentable over Hasegawa (U.S. Patent No. 6,493,561) and in view of Korpela et al (U.S. Patent No. 6,167,283, hereinafter called "Korpela")

In light of the outstanding ground for rejection, the claims have been amended to clarify the claimed invention and thereby more clearly patentably define over the cited prior art. To that end, the amended claims again refer to "provider(s)". In accordance with this amendment, how "priority" and "service" are related in a memory has been recited in relation to --provider(s)--, not "base station." These claim amendments find support in Applicants' disclosure of FIGS. 4 and 7 and the related discussion in the specification. No new matter has been added.

The reference to "provider(s)" has been reintroduced in the claims for two reasons. One is that different providers determine different charging systems, and there is priority among providers. The other reason is that different providers provide different kinds of service.

Hasegawa and Korpela focus on how to select a base station, and fail to show how to select a provider.

On the other hand, according to the Applicants' invention, the priority of base stations which a mobile station is connected to (i.e., the priority of different providers) is stored in the memory of the mobile station. According to Hasegawa, the priority of base station to which a mobile station is connected is determined in accordance with the traffic, and this

determination is made by the base stations (i.e., by the network). Hasegawa does not disclose anything as to how a provider is selected from among different providers (i.e., the priority of different providers).

According to the Applicants' invention, a user makes a request for using service, and in response to the request, a mobile station is connected to a base station of the provider that provides that service. If the mobile station is connected to a base station of a provider that cannot provide the service when the user makes the request for the service, a base station of another provider is selected based on the priority, and the mobile station is connected to that base station.

It is respectfully submitted that Hasegawa and Korpela fail to show that a mobile station is disconnected from a base station of a provider that does not provide service desired by a user and is connected to a base station of a provider that provides the desired service. Accordingly, it is respectfully submitted that the amended claims patentably define over the cited references.

Furthermore, assuming arguendo that the references individually include relevant teachings, it is respectfully submitted that absent hindsight, the cited references are not properly combinable. In particular, according to Korpela, the base stations' class information is stored in a mobile station, and the mobile station refers to the class information when it determines a base station to be connected, based on the profile (best match is searched for). However, in Hasegawa, a mobile station does not have a function of selecting a base station to which it should be connected. If the reception power is lower than a threshold value, Hasegawa can merely reduce the order of priority with reference to the order of priority the base station determines. In short, a mobile station of Hasegawa does not have a function of selecting a base station which it should be connected to, while a mobile station of Korpela has that function. In view of these conflicting teachings, it is respectfully submitted that the

teachings of the cited references are not properly combinable, especially insofar as the motivation to combine apparently is only provided by Applicants' disclosure and not the references themselves.

As noted in Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 56 USPQ2d 1456, 1460 (Fed. Cir., 2000):

.... The statutory standard for the ultimate determination of obviousness provides that a claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103 (1994); see also *Graham*, 383 U.S. at 13. In line with this statutory standard, our case law provides that "[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Two requirements are contained in this criterion.

[1] The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617. However, the suggestion to combine need not be express and "may come from the prior art, as filtered through the knowledge of one skilled in the art." *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

The second requirement is that the ultimate determination of obviousness "does not require absolute predictability of success. ... [A]ll that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). (Emphasis added)

Brown & Williamson, *supra*, reinforces the earlier case, In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769, 1774-1775 (Fed. Cir. 2000), where the Federal Circuit noted:

... Thus, the plain language of §§7 and 144 of Title 35 indicates that we review Board decisions "on the record of an agency hearing provided by statute," and that we should therefore review Board factfinding for "substantial evidence." See also Thomas Leonard Stoll, A Clearly Erroneous Standard of Review, 79 J. Pat. & Trademark Off. Soc'y 100, 106 (1997) (arguing in favor of "substantial evidence" review based on 35 U.S.C. §§7(b) and 144).

...Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. Mere uncorroborated hearsay or rumor does not constitute substantial evidence. (Emphasis added)

In this case, the outstanding Official Action attempts to remedy this deficiency, stating, "[t]he motivation for the modification is to have doing so in order to provide the mobile user an option to select a particular base station for a particular service."¹ No evidentiary support of any kind is given for this conclusion. Further, there is no evidence anywhere, except in Applicants' disclosure that there would have a reasonable likelihood of success, viewed in the light of the prior art, Brown & Williamson, supra. It is therefore respectfully submitted that the substantial evidence standard mandated by Gartside has not been met, that there clearly is insufficient evidence on the record to support the finding of obviousness, and that the outstanding ground for rejection is traversed.

¹Official Action , page 3, lines 7-8.

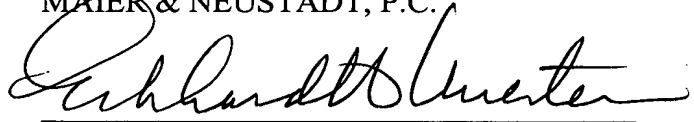
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Consequently, in view of the present amendment, no further issues are believed to be outstanding, and the present application is believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Eckhard H. Kuesters', is written over a horizontal line.

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